REMARKS

Status of the claims:

Upon entry of the instant amendment, claims 7, 10, 12, 15 and 18-21 will remain pending in the instant application and stand ready for further action on the merits.

In the present amendment, claims 8 and 16 have been canceled, claims 7, 10, 12, and 15 has been amended, and claims 18-21 have been added.

No new matter has been added by way of the above amendments. For example, support for the amendment to claim 7 can be found in prior claim 8, now canceled. Support for new claim 18 can be found at page 25, lines 5-7, support for new claim 19 can be found at page 26, lines 10-11, support for new claim 20 can be found at page 4, line 3, and support for new claim 21 can be found at page 13, lines 20-23. Accordingly, entry of the present amendment is respectfully requested at present.

Rejections under 35 USC § 102/103

Pending claims 7-8, 10, 12 and 15 have been rejected under 35 USC §102(b) as being anticipated by, or under 35 USC §103(a) as being unpatentable over Hutcheson '024 (US Patent No.

5,296,024). Reconsideration and withdraw of this rejection is respectfully requested based on the following considerations.

Applicants respectfully submit comparative test results from Experiments that were performed with Example 1 from Hutcheson '024 (*i.e.*, the closest disclosed example)[1]. These comparative test results, which appear as APPENDIX A of this reply in tabular form, provide a conclusion/answer evaluated by adding an agent that promotes fixation of the compound onto the paper sheets.

For example, in APPENDIX A the Examiner can ascertain that Example 1 from Hutcheson '024 has a lyotropic degree of 5.4%, a standard improved bulky value of 0.032 g/cm^3, a standard improved brightness of 0.63 point, and a standard improved opacity of 0.78 point. Instant claim 7 recites all three of a (i) a standard improved bulky value of at least 0.02 g/cm^3, (ii) a standard improved brightness of at least 0.7 point, and (iii) a standard improved opacity of at least 0.7 point. As such, the Examiner should understand that Example 1 from Hutcheson '024 does not fall within the scope of the instant claim 7. In particular, Example 1 of Hutcheson '024 does not satisfy the

[1] Such comparative testing was noted at page 7 of the Amendment filed on March 9, 2004, and is mentioned by the Examiner at page 2, paragraph "2." of the office action of August 30, 2004.

requirement of "a standard improved brightness of at least 0.7 point", instead having a value of 0.63 point. Moreover, Example 1 of Hutcheson '024 does not fall within the scope of any of the rejected claims. For this reason, Hutcheson '024 *cannot* anticipate nor can it render obvious the instant invention as claimed.

More particularly, Hutcheson '024 cannot anticipate the instant invention because Hutcheson '024 fails to disclose all of the elements of the instantly claimed invention and the composition(s), which is/are disclosed in Hutcheson '024 fail to fall within the scope of the claimed invention. Hutcheson '024 also cannot render obvious the instant invention because Hutcheson '024 provides no motivation or suggestion to modify its disclosure so that the composition of Hutcheson '024 falls within the scope of the instantly claimed invention. Thus, a proper *prima facie* case of obviousness has not been presented. The Examiner is reminded that three criteria must be met to make out a proper *prima facie* case of obviousness.

1) *There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.*

2) *There must be a reasonable expectation of success.*

3) The prior art reference (or references when combined) must teach or suggest all the claim limitations.

See MPEP §2142 and *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991). Not only has the first element not been satisfied, but the third element to make a *prima facie* obviousness rejection has also not been satisfied. All of the elements are not present.

Moreover, even if a proper *prima facie* rejection were presented (which Applicants do not concede), the claimed paper of the instant invention is unexpectedly superior to the paper of Hutcheson '024. Thus, for this reason, any obviousness rejection is inappropriate. For this reason and the reasons advanced above, Applicants believe that the rejection has been obviated. Withdrawal of the rejection is warranted and respectfully requested.

Apart from the above considerations, it is noted that claim 7 recites "adding …an agent that promotes fixation of the compound onto the paper sheet to a material pulp before or during a papermaking step", which is in no way suggested or taught in the cited art of Hutcheson '024. Similar language also occurs in pending claims 10 and 12. Based on the failure of the cited Hutcheson '024 reference to teach this aspect of the invention, or to provide any motivation to those of ordinary

skill in the art to arrive at this aspect of the invention, it follows that the Hutcheson '024 disclosure is incapable of properly supporting either of an anticipation or obviousness rejection of the instantly pending claims 7, 10, 12, 15 and 18-21. Any contentions of the USPTO to the contrary must be reconsidered at present.

Rejections under 35 USC § 112, first paragraph

Pending claims 7, 8, 10, 12 and 15 are rejected under 35 USC §112, first paragraph as allegedly not being enabled. The Examiner asserts that the instant invention is not enabled if deinked pulp does not appear in the claims. Reconsideration and withdraw of the rejection is respectfully requested based on the following considerations.

First, claim 8 has been cancelled and its limitations are now recited in claim 7.

Second, Applicants note that claim 15 does have the deinked feature in the claim. Particularly, claim 15 recites "wherein said material pulp contains a deinked pulp in an amount of 10% or more by weight in the material pulp…." Thus, Applicants believe that this rejection should not pertain to claim 15.

Regarding claims 7, 10, and 12, Applicants also traverse for the following reasons. Applicants respectfully point out that the invention can be practiced in a scope commensurate with the claims without undue experimentation. Thus, the claims are fully enabled as presently presented. In particular, Applicants respectfully point out that there are features in the claims that determine the amount of deinked pulp that can be (or cannot be) used in the pulp slurry (please see the description at page 1, line 18 *et seq.*). These features are the brightness and the opacity. Applicants respectfully submit that these features inherently determine the amount of deinked pulp that can be (or cannot be) inserted into the pulp slurry. Accordingly, Applicants respectfully submit that the insertion of the phrase "deinked" into these claims (*i.e.*, claims 7, 10, and 12) is not necessary to have the claims fully enabled. For this reason, the rejection is inapposite.

Moreover, Applicants do not agree with the Examiner's assertion that deinked pulp is an essential ingredient in the composition (or method). Applicants do not believe that page 4 of the written description asserts that deinked pulp is an essential component as asserted by the Examiner. The Examiner is invited to point out why he believes that deinked pulp is a

necessary feature in the claims. For this reason and the reasons advanced above, the rejection is inappropriate and thus. withdrawal of the rejection is warranted at present and respectfully requested.

Conclusion

With the above remarks and amendments, Applicants believe that pending claims 7, 10, 12, 15 and 18-21, as they now stand, define patentable subject matter such that passage of the instant invention to allowance is warranted. A Notice to that effect is earnestly solicited.

If any questions remain regarding the above matters, please contact the undersigned in the Washington metropolitan area at the phone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Enclosure: Appendix A

APPENDIX A

	Compound No.	Name of Compound	Lypotropic Degree (%)	(i) Standard Improved Bulky Value (g/cm^3)	(ii) Standard Improved Brightness (point)	(iii) Standard Improved Opacity (point)
Claimed in claim 7			not less than 4%	at least 0.02 g/cm^3	at least 0.7 point	at least 0.7 point
	blank		0.0	0.000	0.00	0.00
Present Invention	D-12	Pentaerythritol stearate (average esterification degree: 45% by equivalent)	5.6	0.028	1.36	1.70
Hutcheson (US 5296024)	Example 1	Mono- and distearamide of aminoethyletahnolamine	5.4	0.032	0.63	0.78
DE 4202703		Soybean oil EO 4 mol	-1.9	0.003	0.09	-0.13
Ditto		Soybean oil EO 9 mol	7.5	0.008	0.10	0.34
Ditto		Caster oil EO 10 mol	15.3	0.009	0.73	0.27
Ditto		Caster oil EO 30 mol	7.6	0.004	0.88	0.66